

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Kazuhisa YAMASHITA

Serial No.: 08/598,578

Filed: February 12, 1996

For: BRAKE LEVER STROKE ADJUSTING
MECHANISM:
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: Group Art Unit: 3622
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: Examiner: D. Fenstermacher
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: Attn: Diane Terry
: Allowed Files Branch
:
:DECLARATION OF JOHN E. HOLMES IN SUPPORT OF
PETITION TO WITHDRAW THE HOLDING OF ABANDONMENTAssistant Commissioner for Patents
U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

1. I, John E. Holmes, am an attorney in good standing in the District of Columbia, having been admitted to the Bar in 1978. I have been registered to practice before the U.S. Patent and Trademark Office since 1979. My registration number is 29,392.

2. I am a partner at the law firm of Roylance, Abrams, Berdo & Goodman, L.L.P., located at 1225 Connecticut Ave., N.W., Suite 315, Washington, D.C. 20036. The Shinjyu Office of Patent Attorneys, located in Osaka, Japan, has been a client of the Roylance firm since approximately March 1994. Prosecution of U.S. patent application Serial No. 08/598,578 (as with certain other applications filed by the Shinjyu firm) is handled by Shinjyu's own U.S. patent agents who are resident at the firm's main office in Osaka, Japan.

3. In May 1994, the Shinjyu firm expressed concern to the Roylance firm regarding delays in correspondence between Japan and the United States, particularly insofar

as such delays might affect correspondence sent directly to Shinjyu by the U.S. Patent and Trademark Office (USPTO) in connection with the applications being prosecuted by Shinjyu's U.S. patent agents in Osaka. It was Shinjyu's understanding that USPTO correspondence was being forwarded by surface mail, rather than by air mail, resulting in considerable delays in the receipt of office actions and other important correspondence. To remedy this problem, the Shinjyu firm proposed that the Roylance firm's address be listed as the correspondence address for certain patent applications (which were later to include Serial No. 08/598,578) filed by Shinjyu at the USPTO. A detailed procedure was also agreed upon for forwarding to the Shinjyu firm correspondence (including office actions) received from the USPTO, and for filing at the USPTO papers (including original applications and responses to office actions) received from the Shinjyu firm. In the case of correspondence received from the USPTO, this procedure involved sending a copy of the correspondence to Shinjyu by facsimile along with a cover letter explaining the nature of the correspondence, and then sending the original correspondence to Shinjyu by air mail. By agreement with the Shinjyu firm, office actions and other USPTO correspondence having responses due were not to be entered into the Roylance firm's docketing system, nor were copies to be kept, since the Roylance attorneys would not be of record in these applications and would not be responsible for filing the required responses. All docketing and prosecution functions were to be carried out by the patent agents and staff of the Shinjyu firm in Osaka, Japan.

4. The procedure described above has been followed successfully since May 1994. When USPTO correspondence intended for the Shinjyu firm is received by the Roylance

firm, it is given directly to me (without having been docketed) by the Roylance firm's docket clerk, who handles all incoming mail. The correspondence is then sent by facsimile and air mail to the Shinjyu firm. Since May 1994, correspondence relating to a large number of Shinjyu patent applications (probably between 100 and 200) has been handled in this manner. Nevertheless, apart from the present instance involving Serial No. 08/598,578, there has been only one prior instance in which USPTO correspondence failed to reach the Shinjyu firm in an application where the address of the Roylance firm had been listed as the correspondence address. In that instance, the error was determined to be a USPTO error since the correspondence in question had never been received by the Roylance firm.

5. On December 11, 1998, I received a telephone call from Mr. Robbins of the Shinjyu firm informing me that a Shinjyu application had become abandoned due to a failure to pay the issue fee. Mr. Robbins further advised me that the Shinjyu firm had never received a Notice of Allowance in the application which became abandoned. I was later advised by Mr. Robbins that the application in question was Serial No. 08/598,578 (Shinjyu file F0101SN-US). Although it now appears that the Roylance firm forwarded a Notice of Abandonment to the Shinjyu firm in connection with Serial No. 08/598,578 on September 3, 1998, I was not aware at the time the Notice of Abandonment was forwarded that the abandonment was in error. As noted in paragraph 3 above, no docketing records for the Shinjyu applications are maintained by the Roylance firm, and no copies of the Shinjyu application files are maintained by the Roylance firm.

6. Based on the information I have now received from Mr. Robbins, it is my understanding that abandonment of Serial No. 08/598,578 resulted from the failure to pay the issue fee in response to a Notice of Allowance that was allegedly mailed by the USPTO on November 25, 1997. I have made a search of the Roylance firm's files, as detailed below, to locate any indication of a Notice of Allowance in Serial No. 08/598,578 that may have been received by the Roylance firm and/or forwarded to the Shinjyu firm on or after November 25, 1997. No indication of any such Notice of Allowance has been located.

7. All correspondence between the Roylance and Shinjyu firms which relates to USPTO matters is kept in a correspondence file which has been assigned file number 31489 by the Roylance firm. This file is maintained and updated by my secretary and myself. It contains copies of all facsimile cover letters that are sent to the Shinjyu firm to report correspondence received from (or filed at) the USPTO. An example of such a cover letter (which has been redacted but relates to a patent application other than Serial No. 08/598,578) is attached hereto as Exhibit A. I have personally reviewed file number 31489 for the period beginning on the alleged mailing date of November 25, 1997 and ending on December 31, 1997, by which date any correspondence mailed by the USPTO on November 25, 1997 would be expected to have been received. Despite this review, I have not found a letter similar to that of Exhibit A transmitting a Notice of Allowance in Serial No. 08/598,578, nor any other indication that such a notice may have been received from the USPTO or forwarded to the Shinjyu firm. I also have no recollection of receiving such a notice at any time after its alleged mailing date of November 25, 1997. I have also made a thorough search

of my office and have made inquiries with the Roylance firm's docket clerk (who, as noted above, handles all incoming mail) and with other present and former attorneys of the Roylance firm who may have handled correspondence with the Shinjyu firm during the period in question. Despite these efforts, no evidence of receipt of a Notice of Allowance for Serial No. 08/598,578 has been found.

8. As part of my duties at the Roylance firm, I maintain daily time records of the matters I handle. I have checked these records for the period beginning on the alleged mailing date of November 25, 1997 and ending on December 31, 1997. I have found no entries in these time records that refer to Serial No. 08/598,578 or to the Shinjyu firm's internal file number for this application (F0101SN-US), other than an entry for a related divisional application (Shinjyu file F0101SN-US-B) that was filed on December 29, 1997. An entry for Serial No. 08/598,578 or Shinjyu file F0101SN-US would have been present if a "Notice of Allowance" relating to that application had been received by the Roylance firm and forwarded to the Shinjyu firm, since I am the designated attorney at the Roylance firm who handles the forwarding of such correspondence. I was not absent from the office on any working day between November 25, 1997 and December 31, 1997, except for Friday, December 26, 1997. The correspondence file referred to in paragraph 7 above does not indicate that any correspondence was sent to the Shinjyu firm on December 26, 1997.

9. I have attached as Exhibit B hereto redacted copies of my daily time records for December 1, 3, 4, 5, 9, 11, 15, 16, 17, 24, 29 and 30, 1997. These records were chosen since they are the only ones which include entries for Shinjyu matters in which

correspondence was forwarded to the Shinjyu firm from the USPTO (or from the Shinjyu firm to the USPTO) during the period referred to above. As noted in paragraph 8 above, there are no relevant entries for Serial No. 08/598,578 (Shinjyu file F0101SN-US) among these time records. In order to preserve the confidentiality of matters that I am handling for other clients, entries for clients other than the Shinjyu firm have been blocked out in the time records of Exhibit B. Billing amounts and serial numbers for the Shinjyu entries have also been blocked out, but the Shinjyu firm's internal file numbers (where present) have been allowed to remain.

10. I have also checked my monthly billing records in connection with file 31489 for November 1997 and December 1997. Copies of all billing statements for file 31489 during this period are attached hereto as Exhibit C, with titles, serial numbers, patent numbers, assignee names and dollar amounts redacted but with the Shinjyu firm's file numbers shown. Except for the divisional application mentioned earlier, there are no entries in any of these billing records that refer to Serial No. 08/598,578 or to Shinjyu file F0101SN-US, as there would have been if a Notice of Allowance had been received in that application.

11. In view of the foregoing facts, it is my belief that no Notice of Allowance was ever received by the Roylance firm or forwarded to the Shinjyu firm in connection with Serial No. 08/598,578.

I further state that all statements made herein of my own knowledge are true and that all statements made herein on information and belief are believed to be true, and I further understand that willful false statements and the like are punishable by fine or imprisonment,

Declaration of John E. Holmes
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or both, under 18 U.S.C. 1001, and may jeopardize the validity of this application or any patent issuing thereon.

Respectfully Submitted,

John E. Holmes

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Dated: January 20, 1999

F0101SN-US